

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of: Olivier GUITER et al.

Confirmation: 8438

Serial No.: 09/942,818

Art Unit: 2629

Filed: August 29, 2001

Examiner: Alexander S. BECK

For: METHOD AND APPARATUS FOR DISPLAYING INFORMATION IN A
DISPLAY SCREEN REGION IDENTIFIED BY PERMANENT PRINTING

1. INTRODUCTION

This Reply Brief is submitted in response to the Examiner's Answer, mailed April 30, 2008, having a response period ending on June 30, 2008, to analyze the instant claims according to the Examination Guidelines For Determining Obviousness Under 35 U.S.C. 103 in view of *KSR Int'l Co. v. Teleflex Inc.*, 550 U.S. ___, 127 S. Ct. 1727, 82 USPQ2d 1385 (2007), now incorporated in MPEP 2141 (the "KSR Guidelines"), and which came into existence during the prosecution of the instant application.

The *KSR* Guidelines begin with the factual inquiries of *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966) (the "*Graham* factual inquiries") and then the *KSR* Guidelines present seven "rationales" for supporting an obviousness conclusion, MPEP 2143.

Under the *KSR* Guidelines, because none of the seven rationales lead to a conclusion of obviousness, the present claims present patentable subject matter.

2. THE *GRAHAM* FACTUAL INQUIRIES

The *KSR* Guidelines state that the Office personnel must resolve the *Graham* factual inquiries. This is a three part process.

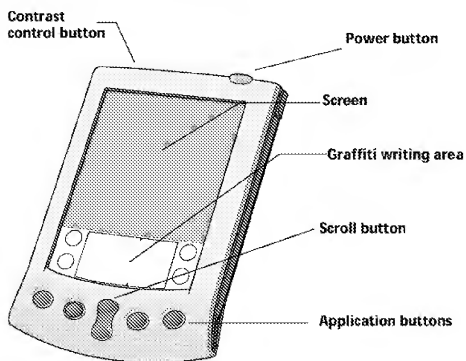
2.1 Determining the scope and content of the prior art

The Examiner has cited four references, and the teaching of each is set forth below.

“Handbook for the Palm V™ Organizer” published by 3Com Corporation in 1999 (“3Com”) was cited as disclosing a method for displaying information comprising a first touch screen region (e.g., graffiti writing area) of a hand held device in an area identified by permanent printing (e.g., icons on application launcher), wherein said hand held device comprises a main display screen region (e.g., screen) distinct from the first touch screen region, said main display screen region free of any area of permanent printing, wherein the first touch screen region is implemented using a first touch screen unit, and said main display screen is implemented using a second display screen unit (3Com, pages 6, 7 and 15-20). The diagram below is from page 6 of 3Com.

Palm V components

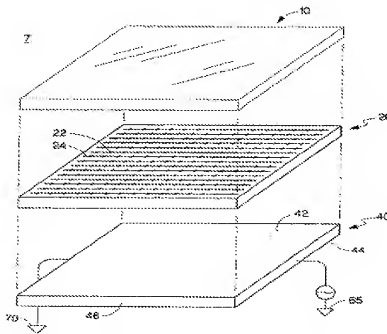
Locating front panel controls



U.S. Patent No. 6,822,640 (Derocher) discloses an illuminated touch pad that presents feedback to user inputs for indicating the operating state of the touch pad (column 7, lines 32-34), and having three layers (Fig. 2 is reproduced below). The first layer, cover 10, is a translucent cover. The second layer, touch sensor 20, is a translucent and conductive material for

accepting user input, namely, the position of a user's finger. The third layer, light-emitting layer 40, is a light emitting material for displaying a trace of a character entered by the user (column 6, lines 61-67), for displaying user-definable soft keys F1-F12 for applications software that accepts soft key input (column 7, lines 1-7), or for displaying other required action:

Further, other applications that occasionally present a window that notifies the user of a specific, required action can present this information by way of the touch pad. The touch pad can then be used to receive the required input, thus providing the user with another means of entering the required information. (column 7, lines 7-12)



Derocher, Fig. 2

U.S. Patent Publication No. 2001/0044319 (Kobayashi) discloses a folding cellphone having upper cabinet 10 and lower cabinet 12. Fig. 2A shows the unit open (unfolded) while Fig. 2B shows the unit closed (folded) (Figs. 2A and 2B are reproduced below). When the cellphone is open, LCD 20 of upper cabinet 10 serves as a display and key unit 22 of lower cabinet 12 accepts input. When the cellphone is closed, simplified LCD 26 of upper cabinet 10 serves as a display and simplified key unit 28 of upper cabinet 10 accepts input. Kobayashi explains,

[0030] Since the folding portable communication unit according to the preferred embodiment is provided with the simplified LCD 26 and the simplified key unit 28 situated on the rear cover 10 a of the upper cabinet 10 in addition to the LCD 20 and the key unit 22, the user can select

either of the two LCDs and either of the two key units depending on the existing conditions. Accordingly, operability of the folding portable communication unit can be improved, and electric power consumed therein can be saved. That is to say, when the upper and lower cabinets 10, 12 are opened, various informations are displayed on the LCD 20, and the user can input the data to be transmitted through the key unit 22 . On the other hand, when the upper and lower cabinets 10, 12 are closed, various informations are displayed on the simplified LCD 26, and the data to be transmitted from the user is inputted through the simplified key unit 28 . Electric power consumed in the LCDs 20, 26 or light-emitting diodes (LEDs, hereinafter) serving as illuminating functions, such as back lights, can be saved by selectively using the LCD 20 together with the key unit 22 and the simplified LCD 26 together with the simplified key unit 28 depending on the existing conditions. Since the simplified LCD 26 is situated on the rear cover 10 a of the upper cabinet 10, a displaying area of the simplified LCD 26 is smaller than that of the LCD 20 .

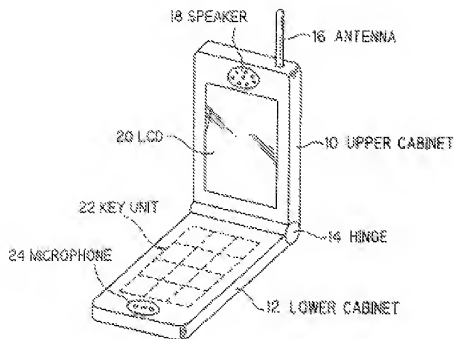
The cellphone has control unit 42 that responds to input from key unit 22 or key unit 28.

Kobayashi teaches

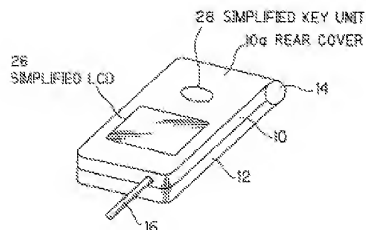
[0034] ... The open/close-detecting switch 46 detects whether the upper and lower cabinets 10 , 12 shown in FIG. 2A are opened or closed. The LCD-driver 48 controls displays of the LCD 20 and the simplified LCD 28. The control unit 42 makes the LCD-driver 48 decide which display is to be used the LCD 20 or the simplified LCD 26 depending on the output signal of the open/close-detecting switch 46 and on the kind of information to be displayed.

Further, explaining control for selecting the display in accordance with the kind of information to be displayed,

[0035] ... since the area of the simplified LCD 26 is smaller than that of the LCD 20 , the LCD-driver 48 makes the simplified LCD 20 display simple information, such as a telephone number or a short message (SMS). On the other hand, WEB information or pictorial information is displayed on the LCD 20 having a wide area. However, the aforementioned control for selecting the display is only an exemplification, and the display may be selected in accordance with the output signal of the open/close-detecting switch 46 . For example, when the upper and lower cabinets 10, 12 are closed, the data inputted through the simplified key unit 28 is displayed on the simplified LCD 26; and when the upper and lower cabinets 10, 12 are opened, the data inputted through the key unit 22 is displayed on the LCD 20 . The method mentioned in the above is desirable because facility for usage increases.



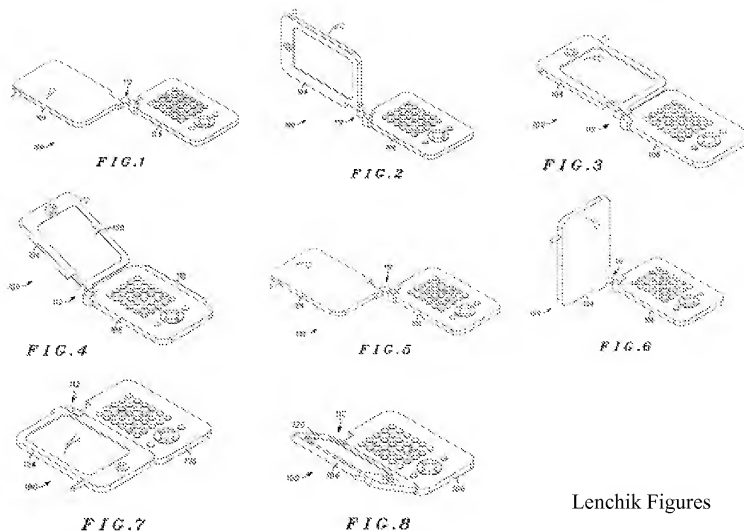
Kobayashi, Fig. 2A



Kobayashi, Fig. 2B

U.S. Patent No. 6,658,272 (Lenchik) discloses a portable electronic device with first electronic element 104 connected by joint 112 to second electronic element 106. Joint 112 allows flexible movement of elements 104 and 106 relative to each other, see Figs. 1-8 (reproduced below). An operational mode of the device is selected based on its physical configuration. Lenchik explains,

As an additional feature, the relative positions of the elements may also select a service to be received. For example, the user may position the two elements **104** and **106** to cause the portable electronic device **100** to self configure as a cellular phone and receive incoming phone calls. The portable electronic device **100** may include an alert that notifies the user that a non-selected service is waiting to be received, such as an incoming page in this example. The user may therefore reposition the elements of the device **100** in order to cause the device **100** to self configure as a pager, whereupon the incoming page may be received and/or responded to. (column 4, lines 53-64)



2.2 Ascertaining the differences between the claimed invention and the prior art

Each of the independent claims is now compared with the cited references.

2.2.1 Claim 5

5. A method for displaying information comprising:
displaying computer generated information in a display screen region of a hand held device in an area identified by permanent printing, wherein said hand held device comprises a main display screen region distinct from said display screen region, said main display screen region free of any area of permanent printing, wherein said display screen region is implemented using a first display screen unit, and said main display screen region is implemented using a second display screen unit; and
displaying said computer generated information on said first display screen unit automatically in response to a signal for turning off said second display screen unit.

3Com teaches:

- a region of a hand held device in an area identified by permanent printing, but this region is a touch screen for accepting input,
- a main display screen region distinct from the touch screen region and free of any area of permanent printing, being implemented using a sole display screen unit.

Derocher teaches a translucent touch screen over a display.

3Com lacks the following features of claim 5:

- the second display screen unit,
- displaying computer generated information in a display screen region of a hand held device in an area identified by permanent printing,
- displaying computer generated information on said first display screen unit automatically in response to a signal for turning off said second display screen unit, as required by claim 5.

Derocher lacks the following features of claim 5:

- permanent printing associated with its display,
- a main display screen, and
- displaying computer generated information on its display screen unit automatically in response to a signal for turning off said the main display screen.

Kobayashi teaches:

- a small display screen region implemented using a first display screen unit,
- a main display screen region implemented using a second display screen unit, and
- displaying computer generated information on the small display screen unit automatically in response to detection of whether its cabinets are folded or unfolded.

Kobayashi lacks the following features of

claim 5:

- permanent printing identifying the small display screen region, and
- a signal for turning off said second display screen unit, and thus displaying computer generated information on the small display screen unit automatically in response to a signal for turning off said second display screen unit.

Lenchik was not cited as relevant to claim 5.

2.2.2 Claim 7

7. A method for displaying information comprising:
displaying computer generated information in a display screen region of a hand held device in an area identified by permanent printing, wherein said hand held device comprises a main display screen region distinct from said display screen region, said main display screen region free of any area of permanent printing, wherein said display screen region is implemented using a first display screen unit, and said main display screen region is implemented using a second display screen unit; and
sending information for a clock display to said first display screen unit automatically in response to a signal for turning off said second display screen unit.

3Com teaches:

- a region of a hand held device in an area identified by permanent printing, but this region is a touch screen for accepting input,
- a main display screen region distinct from the touch screen region and free of any area of permanent printing, being implemented using a sole display screen unit.

Derocher teaches a translucent touch screen over a display.

3Com lacks the following features of claim 7:

- the second display screen unit,
- displaying computer generated information in a display screen region of a hand held device in an area identified by permanent printing,
- sending information for a clock display to said first display screen unit automatically in response to a signal for turning off said second display screen unit.

Derocher lacks the following features of claim 7:

- permanent printing associated with its display,
- a main display screen, and
- sending information for a clock display to said first display screen unit automatically in response to a signal for turning off said second display screen unit.

Kobayashi teaches:

- a small display screen region implemented using a first display screen unit,
- a main display screen region implemented using a second display screen unit, and
- displaying simple computer generated information on the small display screen unit automatically in response to detection of whether its cabinets are folded or unfolded.

Kobayashi lacks the following features of

claim 7:

- permanent printing identifying the small display screen region, and
- a signal for turning off said second display screen unit, and thus sending information for a clock display to said first display screen unit automatically in response to a signal for turning off said second display screen unit.

Lenchik was not cited as relevant to claim 7.

2.2.3 Claim 20

20. A hand held computer system comprising:
a first display screen region for displaying first computer generated information, said first display screen region identified by permanent printing; and
a second display screen region for displaying second information, wherein said first display screen region and said second display screen region are implemented as a first display screen unit, and a distinct second display screen unit;
and wherein said first display screen unit is configured to turn on automatically in response to a signal for turning off said second display screen unit.

3Com teaches:

- a region of a hand held device in an area identified by permanent printing, but this region is a touch screen for accepting input,
- a main display screen region distinct from the touch screen region and free of any area of permanent printing, being implemented using a sole display screen unit.

Derocher teaches a translucent touch screen over a display.

3Com lacks the following features of claim 20:

- the second display screen unit,
- displaying computer generated information in a display screen region of a hand held device in an area identified by permanent printing,
- the first display screen unit being configured to turn on automatically in response to a signal for turning off said second display screen unit.

Derocher lacks the following features of claim 20:

- permanent printing associated with its display,
- a main display screen, and
- the touch screen unit being configured to turn on automatically in response to a signal for turning off the main display screen unit.

Kobayashi teaches:

- a small display screen region implemented using a first display screen unit,
- a main display screen region implemented using a second display screen unit, and
- displaying computer generated information on the small display screen unit automatically in response to detection of whether its cabinets are folded or unfolded.

Lenchik was not cited as relevant to claim 20.

Kobayashi lacks the following features of claim 20:

- permanent printing identifying the small display screen region, and
- a signal for turning off said second display screen unit, and thus displaying computer generated information on the small display screen unit automatically in response to a signal for turning off said second display screen unit.

2.2.4 Claim 24

24. In a hand held computer system, a method for displaying information comprising:

displaying program information on a main display screen region of said hand held computer system;

in response to an event, displaying computer generated information on a second display screen region identified by permanent printing therein, wherein said displaying computer generated information does not interfere with said displaying program information on said main display screen region; and

wherein said event is an incoming phone call and wherein said computer generated information is a dialog enabling the receipt of said phone call.

3Com teaches:

- a region of a hand held device in an area identified by permanent printing, but this region is a touch screen for accepting input,
- a main display screen region distinct from the touch screen region and free of any area of permanent printing, being implemented using a sole display screen unit.

Derocher teaches a translucent touch screen over a display.

3Com lacks the following features of claim 24:

- the second display screen region,
- in response to an event, displaying computer generated information on the second display screen region to not interfere with displaying program information on the main display screen region,
- the event is an incoming phone call and wherein the computer generated information is a dialog enabling the receipt of the phone call.

Derocher lacks the following features of claim 24:

- permanent printing associated with its display,
- a main display screen,
- in response to an event, displaying computer generated information on the second display screen region to not interfere with displaying program information on the main display screen

region,

- the event is an incoming phone call and wherein the computer generated information is a dialog enabling the receipt of the phone call.

Lenchik teaches:

- displaying program information on a main display screen region of a handheld computer system,
- an event that is an incoming phone call.

Lenchik lacks the following features of claim 24:

- a second display screen region identified by permanent printing
- in response to an event, displaying computer generated information on the second display screen region to not interfere with displaying program information on the main display screen region
- wherein the computer generated information is a dialog enabling the receipt of the phone call.

Lenchick teaches that in response to an alert for a non-selected service, the user may reposition the elements of the device to enable the non-selected service.

Kobayashi was not cited as relevant to claim 24.

2.3 Resolving the level of ordinary skill in the pertinent art

The pertinent art has not yet been addressed. The level of ordinary skill in the pertinent art has also not been addressed.

Applicant submits that the pertinent art is hand held computing devices that have communications ability. The references cited by the Examiner are all in what applicant considers the pertinent art.

Applicant submits that the level of ordinary skill is that possessed by an engineer with about three years experience working with hardware and software for hand held computing devices.

3. NONE OF THE SEVEN KSR RATIONALES PROPERLY INDICATES OBVIOUSNESS

For each of the seven rationales set forth in the MPEP, the procedure that must be applied is presented in Arial indented single-spaced text, followed by an application of the procedure to the facts of the instant case. For each rationale, there are specific distinctions that preclude an obviousness conclusion, and so the only proper conclusion is that the claims are patentable.

3.1 Combining prior art elements according to known methods to yield predictable results

To reject a claim based on this rationale, Office personnel must resolve the *Graham* factual inquiries. Then, Office personnel must articulate the following:

(1) a finding that the prior art included each element claimed, although not necessarily in a single prior art reference, with the only difference between the claimed invention and the prior art being the lack of actual combination of the elements in a single prior art reference;

(2) a finding that one of ordinary skill in the art could have combined the elements as claimed by known methods, and that in combination, each element merely performs the same function as it does separately;

(3) a finding that one of ordinary skill in the art would have recognized that the results of the combination were predictable; and

(4) whatever additional findings based on the *Graham* factual inquiries may be necessary, in view of the facts of the case under consideration, to explain a conclusion of obviousness.

3.1.1 Step 1, prior art finding for combining prior art elements according to known methods to yield predictable results

Step 1 requires that all claimed elements be found somewhere in the prior art. As shown in Tables 1-4 at the end of this document, there are claimed elements not found in any of the references.

Specifically, each of claims 5, 7, 20 and 24 requires a display screen region identified by permanent printing. None of the prior art references shows this. 3Com shows a touch screen region identified by permanent printing. Derocher shows a translucent touch screen overlaid over a display. The Examiner's Answer asserts that one of ordinary skill in the art would have been motivated to put Derocher's display behind 3Com's touch screen with permanent printing to provide the user with another way to *enter* information (Examiner's Answer, top of page 5). However, adding a display does not provide another way to *enter* information, it provides another way to *display* information.

Even if the Examiner had provided the motivation of "another way to *display* information", this would not be meaningful in context. 3Com's touch screen is right next to a big display screen. In contrast, Derocher's touch screen is not shown as being right next to a display, so it is understandable that local display capability is meaningful for Derocher; such local display capability is already present in 3Com.

Table 1, comparing claim 5 with the prior art, shows that none of the prior art references teaches displaying computer generated information in response to a signal for turning off a second display screen unit, as required by claim 5. Kobayashi teaches an open/close detecting switch that produces a signal, and selecting either its small display or its main display based on the switch output. In context, this is meaningful for Kobayashi because when Kobayashi's cellphone is closed, there is no point in displaying information on its main screen as no user will ever see the information due to the closure of the cabinets. Kobayashi would lead one of ordinary skill to put a second display on 3Com's device, with the second display being visible only when the 3Com main display is closed, but since 3Com's device does not fold up as does Kobayashi's, there is no closure and no reason to add a second display. The claimed signal for turning off the second display screen unit would be utterly misplaced in Kobayashi, as it would force the user to close the cellphone to enable viewing of the small display on the outside of the cellphone; this is a dysfunctional scenario as the cellphone would be demanding behavior of the user rather than responding to how the user wants to use it. In short, the cited prior art teaches away from the claimed signal for turning off the second display screen unit.

Table 2, comparing claim 7 with the prior art, shows that none of the prior art references teaches sending information for a clock display to the first display screen unit automatically in response to a signal for turning off the second display screen unit, as required by claim 7. As discussed above, the cited prior art does not show a signal for turning off the second display screen unit; indeed, the cited prior art teaches away from this.

Table 3, comparing claim 20 with the prior art, shows that none of the prior art references teaches the first display screen being configured to turn on automatically in response to a signal for turning off the second display screen unit, as required by claim 20. As discussed above, the

cited prior art does not show a signal for turning off the second display screen unit; indeed, the cited prior art teaches away from this.

Table 4, comparing claim 24 with the prior art, shows that none of the prior art references teaches displaying a computer generated dialog enabling the receipt of an incoming phone call, as required by claim 24. Lenchik teaches an incoming phone call, and when this is a non-selected service, alerting the user so that the user can reposition the elements of the device to enable operation of the non-selected service. An alert is not a dialog that enables. Lenchik's enabling is provided by the user twisting the parts of Lenchik's device via the hinge.

3.1.2 Step 2, “could have combined” finding for combining prior art elements according to known methods to yield predictable results

Since Step 1 has not been satisfied, it is improper to proceed to step 2.

Applicant respectfully suggests that the Board should either find that the claims present patentable subject matter, or return this case to the Examiner for an opportunity to carefully follow the *KSR* Guidelines, which came into being after the Examiner wrote his Office Actions.

3.1.3 Step 3, predictability finding for combining prior art elements according to known methods to yield predictable results

Since Step 1 has not been satisfied, it is improper to proceed to step 3.

3.1.4 Step 4, additional findings for combining prior art elements according to known methods to yield predictable results

Since Step 1 has not been satisfied, it is improper to proceed to step 4.

3.2 Simple substitution of one known element for another to obtain predictable results

To reject a claim based on this rationale, Office personnel must resolve the *Graham* factual inquiries. Then, Office personnel must articulate the following:

- (1) a finding that the prior art contained a device (method, product, etc.) which differed from the claimed device by the substitution of some components (step, element, etc.) with other components;
- (2) a finding that the substituted components and their functions were known in the art;
- (3) a finding that one of ordinary skill in the art could have substituted one known element for another, and the results of the substitution would have been predictable; and
- (4) whatever additional findings based on the *Graham* factual inquiries may be necessary, in view of the facts of the case under consideration, to explain a conclusion of obviousness.

In view of the cited prior art, this rationale is inapplicable. There is nothing in the 3Com reference that was replaced by another component. Rather, the Examiner used other references to add to the 3Com reference.

3.3 Use of known technique to improve similar devices (methods, or products) in the same way

To reject a claim based on this rationale, Office personnel must resolve the *Graham* factual inquiries. Then, Office personnel must articulate the following:

- (1) a finding that the prior art contained a "base" device (method, or product) upon which the claimed invention can be seen as an "improvement;"
- (2) a finding that the prior art contained a "comparable" device (method, or product that is not the same as the base device) that has been improved in the same way as the claimed invention;
- (3) a finding that one of ordinary skill in the art could have applied the known "improvement" technique in the same way to the "base" device (method, or product) and the results would have been predictable to one of ordinary skill in the art; and
- (4) whatever additional findings based on the *Graham* factual inquiries may be necessary, in view of the facts of the case under consideration, to explain a conclusion of obviousness.

In view of the cited prior art, this rationale is inapplicable. Assuming that the 3Com reference is a “base” device, nothing has been cited as a “comparable” device improved in the same way as the claimed invention.

3.4 Applying a known technique to a known device (method, or product) ready for improvement to yield predictable results

To reject a claim based on this rationale, Office personnel must resolve the *Graham* factual inquiries. Then, Office personnel must articulate the following:

- (1) a finding that the prior art contained a "base" device (method, or product) upon which the claimed invention can be seen as an "improvement;"
- (2) a finding that the prior art contained a known technique that is applicable to the base device (method, or product);
- (3) a finding that one of ordinary skill in the art would have recognized that applying the known technique would have yielded predictable results and resulted in an improved system; and
- (4) whatever additional findings based on the *Graham* factual inquiries may be necessary, in view of the facts of the case under consideration, to explain a conclusion of obviousness.

This rationale is inapplicable in this case. Even assuming that the 3Com device is a “base” device upon which the claimed invention can be seen as an improvement, there is no finding that the prior art contained a known technique applicable to the base device that would have yielded predictable results and resulted in an improved system. To date, it appears that the Examiner has used the present invention as a hindsight lens for cherry-picking elements of the prior art and then has wrongly asserted that the cherry-picked elements satisfy the features of the claims (see discussion for section 3.1.1).

3.5 "Obvious to try" - choosing from a finite number of identified, predictable solutions, with a reasonable expectation of success

To reject a claim based on this rationale, Office personnel must resolve the *Graham* factual inquiries. Then, Office personnel must articulate the following:

- (1) a finding that at the time of the invention, there had been a recognized problem or need in the art, which may include a design need or market pressure to solve a problem;
- (2) a finding that there had been a finite number of identified, predictable potential solutions to the recognized need or problem;
- (3) a finding that one of ordinary skill in the art could have pursued the known potential solutions with a reasonable expectation of success; and
- (4) whatever additional findings based on the *Graham* factual inquiries may be necessary, in view of the facts of the case under consideration, to explain a conclusion of obviousness.

This rationale is inapplicable in this case. There has been no finding relating to a recognized problem or need in the art. There has been no finding of a finite number of identified, predictable potential solutions to anything.

3.6 Known work in one field of endeavor may prompt variations of it for use in either the same field or a different one based on design incentives or other market forces if the variations are predictable to one of ordinary skill in the art

To reject a claim based on this rationale, Office personnel must resolve the *Graham* factual inquiries. Then, Office personnel must articulate the following:

- (1) a finding that the scope and content of the prior art, whether in the same field of endeavor as that of the applicant's invention or a different field of endeavor, included a similar or analogous device (method, or product);
- (2) a finding that there were design incentives or market forces which would have prompted adaptation of the known device (method, or product);

(3) a finding that the differences between the claimed invention and the prior art were encompassed in known variations or in a principle known in the prior art;

(4) a finding that one of ordinary skill in the art, in view of the identified design incentives or other market forces, could have implemented the claimed variation of the prior art, and the claimed variation would have been predictable to one of ordinary skill in the art; and

(5) whatever additional findings based on the *Graham* factual inquiries may be necessary, in view of the facts of the case under consideration, to explain a conclusion of obviousness.

This rationale is inapplicable in this case. Even assuming *arguendo* that the 3Com reference teaches a similar device as what is claimed, there has been no finding relating to design incentives or market forces.

3.7 Some teaching, suggestion, or motivation in the prior art that would have led one of ordinary skill to modify the prior art reference or to combine prior art reference teachings to arrive at the claimed invention

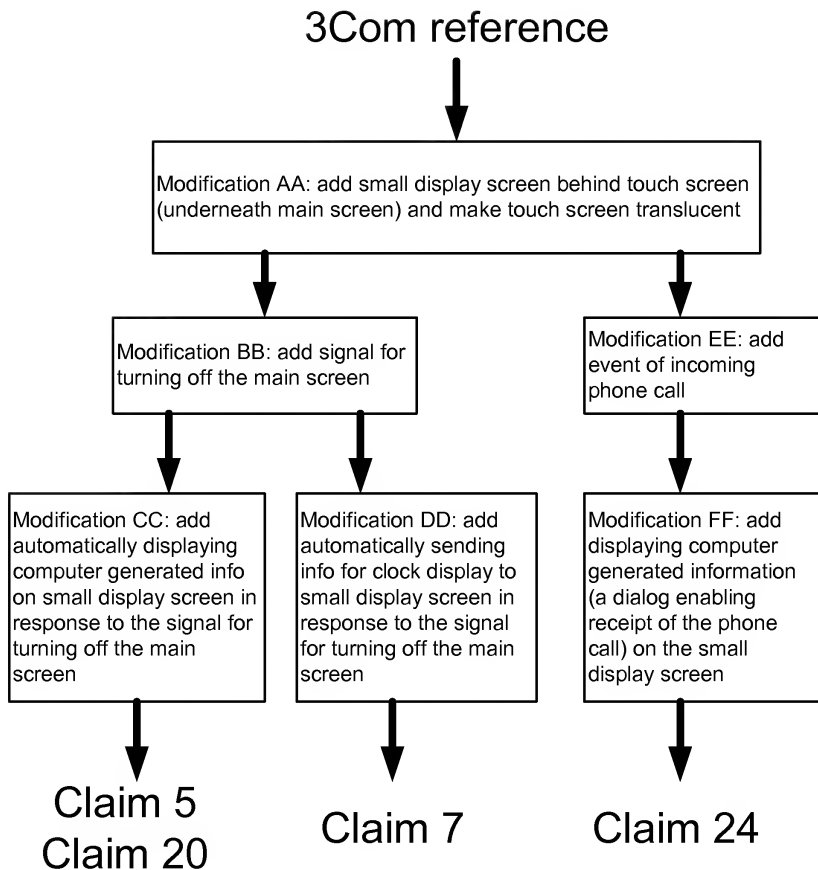
To reject a claim based on this rationale, Office personnel must resolve the *Graham* factual inquiries. Then, Office personnel must articulate the following:

(1) a finding that there was some teaching, suggestion, or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings;

(2) a finding that there was reasonable expectation of success; and

(3) whatever additional findings based on the *Graham* factual inquiries may be necessary, in view of the facts of the case under consideration, to explain a conclusion of obviousness.

Before considering whether there was any teaching, suggestion or motivation (TSM) to combine references, it is necessary to identify the proposed combination. Following is a graphic roadmap of modifications needed to go from the 3Com reference to the claimed inventions, and then a discussion of the motivation for the modifications.



3.7.1 Step 1, TSM finding for some teaching, suggestion, or motivation in the prior art that would have led one of ordinary skill to modify the prior art reference or to combine prior art reference teachings to arrive at the claimed invention

Starting with the 3Com reference, Modification AA (see graphic above) comprises adding a small display screen behind the touch screen, and making the touch screen translucent. Derocher shows a display screen behind its touch screen.

The Examiner explained that the motivation for Modification AA is to provide a user with another means for *entering* information (Examiner's Answer, top of page 5). As mentioned above, a display screen is not for *entering* information, it is for *displaying* information. Assuming this correction, the proposed motivation for Modification AA is to provide a user with another means for *displaying* information.

The proposed motivation for Modification AA is not explicitly found in any of the references.

The proposed modification is thus arising from the general common sense of one of ordinary skill. But, one of ordinary skill would notice that 3Com already has a big main display area, and would be led away from adding more displays in order to minimize the cost, and reduce the weight, complexity and power consumption of the hand held device.

Therefore, in view of these competing design constraints, one of ordinary skill would not be motivated to make the hand held device more expensive, heavier, complicated and power hungry, simply to attain a tiny little display area right next to an existing big display area.

Since one of ordinary skill in the art would not be motivated to perform Modification AA, the obviousness inquiry can stop here with a conclusion of non-obviousness.

For hypothetical discussion purposes, applicant analyzes the rest of the Examiner's proposed TSM findings; none of them rise to the level of satisfying the *KSR* Guidelines.

Modification BB comprises adding a signal for turning off the main screen.

The cited prior art does not show a signal for turning off the main screen.

Kobayashi teaches an open/close detecting switch for detecting whether its cabinets are open or closed. One of ordinary skill would not be motivated to add this to 3Com, since 3Com

has only one cabinet, and thus is always open, so there is no point in trying to detect when it is closed.

So, what the Examiner is inherently proposing is that a signal for turning off the main screen is notoriously well-known. Applicant notes that the Examiner should have stated this, not forced applicant to the position of trying to figure out what the Examiner meant by not carrying his burden of presenting a proper obviousness rejection.

Assuming *arguendo* that the Examiner had asserted that a signal for turning off the main screen is notoriously well-known, such a signal might hypothetically arise from an explicit user action, or automatically from power-saver circuitry. If from an explicit user action, then one of ordinary skill would understand that the user wishes to no longer use the device, and so would not be motivated to make a newly added small display pop-on despite the user's explicit command to turn off the hand held device. If from automatic power-saver circuitry, then one of ordinary skill would not add the power consumption of turning on a newly added small display as that is contrary to the purpose of power-saver circuitry.

Therefore, even if the prior art shows a signal for turning off the main screen, one of ordinary skill would not have been motivated to modify the 3Com reference to include such a signal.

Since one of ordinary skill in the art would not be motivated to perform Modification BB, the obviousness inquiry for claims 5, 7 and 20 can stop here with a conclusion of non-obviousness.

Modification CC comprises adding automatically displaying computer generated information on the newly added small display screen in response to the signal for turning off the

main screen. Derocher teaches displaying computer generated information on its screen, but not in response to the required signal for turning off the main screen.

The Examiner explained that the motivation for Modification CC is to reduce power consumption (Examiner's Answer, middle of page 5), and cited Kobayashi at [0030] as disclosing the motivation of reducing power consumption.

To recap, one of ordinary skill in the art has started with the 3Com device and has, contrary to proper size, weight, complexity and power concerns, added a second small display, and then created a signal for turning off the main display for no reason whatsoever, and then decided to display computer generated information on the small screen after the main screen has been turned off, to reduce power consumption. This is paradoxical. After the main screen is turned off, power consumption is reduced by not turning on anything else, rather than turning on a small screen. So, the Examiner's cited motivation actually *teaches away* from Modification CC.

When the prior art teaches away from a modification, then the modification is non-obvious. Thus, even under the strained hypothetical assumed above, Modification CC is non-obvious.

Modification DD comprises automatically sending information for a clock display to the newly added small display screen in response to the signal for turning off the main screen. The Examiner cited 3Com, page 23, as teaching displaying information for a clock on its main screen, but of course, not in response to the required signal for turning off the main screen.

The Examiner explained that the motivation for Modification DD is to increase user convenience (Examiner's Answer, top of page 6).

To recap, one of ordinary skill in the art has started with the 3Com device and has, contrary to proper size, weight, complexity and power concerns, added a second small display, and then created a signal for turning off the main display for no reason whatsoever, and then decided to display clock information on the small screen after the main screen has been turned off, for user convenience, despite 3Com already having clock display on its main screen. This is not persuasive. If the user wanted a clock display, the user could have just not turned off the main display; that is the simplest, most convenient way of displaying a clock to the user. Thus, the Examiner is asserting that the function performed by the 3Com device should be done in a different way to achieve the same result with regard to user convenience, or in fact, a worse result since the clock display can be bigger (easier to see) on the main screen.

The so-called “function way result” test is one way of determining whether an accused infringing device is equivalent under the Doctrine of Equivalents to a claimed device. Here, the Examiner’s proposed modification performs the same function in a different way to achieve the same result, and thus fails the test for equivalence. This failure leads away from a conclusion of obviousness and is evidence of non-obviousness for Modification DD.

Modification EE comprises adding an event of an incoming phone call. Lenchik teaches an incoming phone call.

The Examiner explained that the motivation for Modification EE is to enable a personal digital assistant to function as a cellphone (Examiner’s Answer, top of page 7).

Arguendo, one of ordinary skill would like to make a personal digital assistant function as a cellphone.

Modification FF comprises adding displaying computer generated information, specifically, a dialog enabling receipt of the incoming phone call, on the newly added small display screen.

The cited prior art does not show a dialog enabling receipt of an incoming phone call.

Lenchik shows an alert to prompt a user to reconfigure its hand held device to enable receipt of a non-selected service.

So, what the Examiner is inherently proposing is that a dialog enabling receipt of an incoming phone call on a newly added small display – added contrary to proper size, weight, complexity and power concerns – is notoriously well-known. Applicant notes that the Examiner should have stated this, not forced applicant to the position of trying to figure out what the Examiner meant by not carrying his burden of presenting a proper obviousness rejection.

Applicant respectfully traverses the inherent proposal by the Examiner. Generally, a cellphone indicates an incoming call by either ringing alone (if there is no display) or a combination of ringing and providing a display of the calling number (if there is a display). The user responds by pressing a talk button. It is simply not generally known for cellphones to force users to engage in a dialog to enable receipt of phone calls.

No motivation was provided for Modification FF.

Since the claimed feature of displaying computer generated information, specifically, a dialog enabling receipt of the incoming phone call, on the newly added small display screen is not shown in the prior art, and no motivation has been provided for this unshown feature, the only proper conclusion is that Modification FF is non-obvious.

3.7.2 Step 2, expectation of success finding for some teaching, suggestion, or motivation in the prior art that would have led one of ordinary skill to modify the prior art reference or to combine prior art reference teachings to arrive at the claimed invention

Since Step 1 has not been satisfied, it is improper to proceed to step 2.

3.7.3 Step 3, additional finding for some teaching, suggestion, or motivation in the prior art that would have led one of ordinary skill to modify the prior art reference or to combine prior art reference teachings to arrive at the claimed invention

Since Step 1 has not been satisfied, it is improper to proceed to step 3.

4. CONCLUSION

Under the *KSR* Guidelines, since none of the seven rationales leads to a conclusion of obviousness, the present claims present patentable subject matter.

Respectfully submitted,

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TABLE 1

Present Claim	3Com	Derocher	Kobayashi
5. A method for displaying information comprising: displaying computer generated information in a display screen region of a hand held device in an area identified by permanent printing, wherein said hand held device comprises a main display screen region distinct from said display screen region, said main display screen region free of any area of permanent printing,	not taught (3Com teaches a touch screen region identified by permanent printing, but a touch screen does not display information) not taught (3Com shows only a main display screen region)	not taught (Derocher displays information in a display behind a translucent touch screen not identified by permanent printing) not taught (Derocher has only one display screen)	not taught (Kobayashi displays information in a small screen and on a main screen, but neither has permanent printing) shown in Kobayashi
wherein said display screen region is implemented using a first display screen unit, and said main display screen region is implemented using a second display screen unit; and displaying said computer generated information on said first display screen unit automatically in response to a signal for turning off said second display screen unit.	not taught (3Com shows only a main display screen region) not taught	not taught (Derocher has only one display screen) not taught	shown in Kobayashi not taught (Kobayashi teaches responding to the output of an open/close detecting switch, which is distinct from a signal for turning off)

TABLE 2

Present Claim	3Com	Derocher	Kobayashi
7. A method for displaying information comprising:			
displaying computer generated information in a display screen region of a hand held device in an area identified by permanent printing,	not taught (3Com teaches a touch screen region identified by permanent printing, but a touch screen does not display information)	not taught (Derocher displays information in a display behind a translucent touch screen not identified by permanent printing)	not taught (Kobayashi displays information in a small screen and on a main screen, but neither has permanent printing)
wherein said hand held device comprises a main display screen region distinct from said display screen region, said main display screen region free of any area of permanent printing,	not taught (3Com shows only a main display screen region)	not taught (Derocher has only one display screen)	shown in Kobayashi
wherein said display screen region is implemented using a first display screen unit, and said main display screen region is implemented using a second display screen unit; and	not taught (3Com shows only a main display screen region)	not taught (Derocher has only one display screen)	shown in Kobayashi
sending information for a clock display to said first display screen unit automatically in response to a signal for turning off said second display screen unit.	not taught	not taught	not taught (Kobayashi teaches responding to the output of an open/close detecting switch, which is distinct from a signal for turning off, by sending information for a clock display)

TABLE 3

Present Claim	3Com	Derocher	Kobayashi
20. A hand held computer system comprising: a first display screen region for displaying first computer generated information, said first display screen region identified by permanent printing; and a second display screen region for displaying second information,	not taught (3Com teaches a touch screen region identified by permanent printing, but a touch screen does not display information)	not taught (Derocher displays information in a display behind a translucent touch screen not identified by permanent printing)	not taught (Kobayashi displays information in a small screen and on a main screen, but neither has permanent printing)
wherein said first display screen region and said second display screen region are implemented as a first display screen unit, and a distinct second display screen unit;	not taught (3Com shows only a main display screen region)	not taught (Derocher has only one display screen)	shown in Kobayashi
and wherein said first display screen unit is configured to turn on automatically in response to a signal for turning off said second display screen unit.	not taught	not taught (Derocher has only one display screen)	shown in Kobayashi
		not taught	not taught (Kobayashi teaches responding to the output of an open/close detecting switch, which is distinct from a signal for turning off)

TABLE 4

Present Claim	3Com	Derocher	Lenchik
24. In a hand held computer system, a method for displaying information comprising:			
displaying program information on a main display screen region of said hand held computer system;	shown in 3Com	not taught (Derocher displays information in a display behind a translucent touch screen not part of a hand held computer system)	shown in Lenchik
in response to an event, displaying computer generated information on a second display screen region identified by permanent printing therein, wherein said displaying computer generated information does not interfere with said displaying program information on said main display screen region; and wherein said event is an incoming phone call and	not taught (3Com shows only a main display screen region. 3Com teaches a touch screen region identified by permanent printing, but a touch screen does not display information.)	not taught (Derocher has only one display screen)	not taught (Lenchik lacks a second display screen region identified by permanent printing)
wherein said computer generated information is a dialog enabling the receipt of said phone call.	not taught	not taught	Lenchik teaches an incoming phone call, but the response is not as set forth in the preceding claim paragraph not taught (Lenchik teaches that the user must reconfigure the device which is different than a computer generated dialog)